

Claims 1 and 10

The Examiner alleged that *Van De Vanter* describes locating a cursor over existing text. The cited section of *Van De Vanter* describes "moving the insertion point over the editable elements" and thus, only contemplates that an insertion point can be positioned over existing elements. In contrast, Claim 1 recites determining whether or not a location of a cursor in an electronic document is positioned over existing text, such as existing paragraph marks, existing characters or existing spaces. The cited section of *Van De Vanter* does not describe determining whether a location of a cursor is positioned over existing text because *Van De Vanter* only permits an insertion point to be positioned over existing elements.

Moreover, the cited section (Col. 21, lines 65-67) of *Van De Vanter* discusses an insertion point, not a cursor. The method of claim 1 is a "method for placing an insertion point" (emphasis added) by "determining ... a location of a cursor" (emphasis added). In other words, an insertion point and a cursor as contemplated by claim 1 are not the same elements. Applicant respectfully submits that the Office Action rejection is improperly treating an insertion point and a cursor as the same elements.

The Examiner also alleged that *Fukunaga* describes collecting contextual formatting information of text lines proximate to a cursor position not located over text. The cited sections of *Fukunaga* describe that a cursor is positioned at the left margin of an existing line of text. The cursor of Figure 4 of *Fukunaga* is located on the same line as the existing text, "At hockheed Corp., whose very...". In other words, the cursor is positioned over existing spaces on the line. Claim 1 has been amended to clarify that the cursor can be positioned in a location that is not over existing paragraph marks, existing characters or existing spaces. By allowing the cursor to be positioned in a location that is not over existing text, the claimed invention "allows a user to place an insertion point at various points within an electronic document without having to manually add spaces, tabs or carriage returns to the document." Application, page 6, last paragraph. In contrast, the cited section of *Fukunaga* describes that a cursor is positioned at various points of an existing line of text. The cited section of *Fukunaga* does not describe that a cursor can be positioned in a location that is not located within an existing line of text. Moreover, the cited sections of *Fukunaga* do not describe, teach or suggest "collecting context information".

The Examiner alleged that it would have been obvious to combine *Van De Vanter* and *Fukunaga* because *Fukunaga* collects format information and the combination would provide "a

way to establish format and display correspondence to *Van De Vanter*." There is no motivation to combine *Van De Vanter* and *Fukunaga* in the manner asserted by the Examiner. *Van De Vanter* describes tools to assist in editing a computer program, whereas *Fukunaga* describes that different formatting can be applied to sentences on a line by line basis. There is no suggestion in *Van De Vanter* that it would be beneficial to be able to change the formatting of a computer program on a line by line basis. Moreover, even if the references are combined, the combination does not describe the invention of Claim 1 because neither reference describes the ability to position a cursor in a location that is not over existing text (where the existing text includes existing spaces).

The Examiner admitted that *Van De Vanter* does not describe that the cursor indicates the formatting that will be applied to text and objects located in close proximity to the cursor location. However, the Examiner alleged that *Fukunaga* describes displaying formatting information proximate to the cursor location at Figures 3 and 4. Figures 3 and 4 of *Fukunaga* illustrate that formatting information is displayed to the user in a format display area (301). The formatting information is only conveyed via the format display area. The presentation of the cursor is not affected. Thus, *Fukunaga* does not describe the invention of Claim 1 because *Fukunaga* does not describe changing a presentation of the cursor to indicate a type of formatting that will be applied to text and objects located in close proximity to the cursor location.

The Examiner also admitted that *Van De Vanter* does not describe performing formatting. However, the Examiner alleged that *Fukunaga* describes performing formatting relative to cursor placement at Figures 3 and 4. Figures 3 and 4 illustrate that different lines of text can have different formatting, such as different margins. In contrast, Claim 1 recites performing formatting to place the insertion point in the electronic document. Neither *Van De Vanter* nor *Fukunaga* describe performing formatting to place the insertion point in the document. *Van De Vanter* describes an insertion point within existing text and *Fukunaga* describes that different lines of text can have different formatting. Again, Applicant is not claiming the concept of formatting itself. Instead, Applicant is claiming performing formatting to place the insertion point in the electronic document which neither *Van De Vanter* nor *Fukunaga* describe, teach or suggest.

The Examiner rejected Claim 10 by essentially repeating the arguments made in rejecting Claim 1. The remarks made above in support of Claim 1 are equally applicable to distinguish Claim 10 from the cited references.

Claims 4 and 13-15

The Examiner admitted that *Van De Vanter* does not describe repeating the steps recited by Claim 1, if an indication has not been received to place the insertion point in the electronic document. However, the Examiner alleged that *Van De Vanter* describes repeating the visual offset calculation of alignment markers. The alignment markers described by *Van De Vanter* are used to align text on different lines. See Figures 7A, 7B and 7C. However, the alignment markers described by *Van De Vanter* are distinguishable from the insertion point recited by Claim 4. An insertion point indicates "the point at which elements may be added to an electronic document" (Application, page 1, second paragraph), whereas an alignment mark forces a horizontal alignment between associated lines of text (Column 37, lines 50-61).

The Examiner rejected Claims 13 and 14 by essentially repeating the arguments made in rejecting Claim 4. The remarks made above in support of Claim 4 are equally applicable to distinguish Claims 13 and 14 from the cited references.

The Examiner rejected Claim 15 by essentially repeating the arguments made in rejecting Claims 1, 10 and 4. The remarks made above in support of Claims 1, 10 and 4 are equally applicable to distinguish Claim 15 from the cited references.

Claim 5

The Examiner admitted that *Van De Vanter* does not describe adding and deleting formatting properties from the electronic document. However, the Examiner alleged that *Fukunaga* describes changing format properties. Although *Fukunaga* describes that different lines of a sentence can have different formatting, *Fukunaga* does not describe that formatting properties are added and deleted from the electronic document to place an insertion point in the electronic document, as recited by Claim 5. Table 2 of the instant application provides examples of the type of formatting properties that can be added and deleted from the document. See Application, pages 19-28. For example, if Rule 5 is used, then an EOP (end of paragraph mark) is inserted in the previous line style and the line is left aligned. Adding and deleting formatting properties is not described, taught or suggested by either *Fukunaga* or *Van De Vanter*.

Claim 6

The Examiner rejected Claim 6 by citing Column 4, lines 25-33 and column 21, lines 65-67 of *Van De Vanter*. The cited sections of *Van De Vanter* only contemplate an insertion point within existing text. "The present editor 122 supports three basic text-oriented editing operations.

These three basic editing operation are: (1) inserting a non-space character; (2) deleting an editable element and (3) inserting a space." Column 21, lines 59-63. Thus, *Van De Vanter* does not describe determining whether a location of a cursor is positioned over existing text in response to a change in the location of the cursor, as recited by Claim 6.

Claim 12

The Examiner alleged that *Van De Vanter* describes alignment markers placed around tokens for centering lines, and automatic alignment between lines. The alignment markers described by *Van De Vanter* are not associated with a cursor. In contrast, Claim 12 recites that the cursors comprise a left alignment icon, a right alignment icon, a center alignment icon and a text wrap icon.

Dependent Claims

Claims 3-6 and 19-20 and 11-14 depend from independent Claims 1 and 10 respectively. The remarks made above in support of the independent claims are equally applicable to distinguish the dependent claims from the cited references.

Claims 7-9 and 16-18

The Office Action rejects claims 7-9 and 16-18 under 35 U.S.C. §103(a) as being unpatentable over *Van De Vanter* and *Fukunaga* and further in view of *Gipson* (U.S. Patent No. 5,778,402). Without acquiescing to the statements made therein, Applicant traverses the rejection as *Gipson* cannot be considered as a reference. *Gipson* and the present invention were commonly owned at the time the present invention was made as evidenced by the fact that both *Gipson* and the present application have assignments recorded in the Patent and Trademark Office which convey the entire rights in the patents to the same organization (Microsoft Corporation). 35 U.S.C. §103(c) applies because a continuing prosecution application under 37 C.F.R. §1.53(d) was filed after November 29, 1999.

Therefore, Applicant respectfully traverses the rejection of claims 7-9 and 16-18 and submits that claims 7-9 and 16-18 should be allowed.

In view of the foregoing, it is respectfully submit that the pending claims, as amended, are patentable over the cited references. The preceding arguments are based only the arguments

in the Official Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Official Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Notification of New Power of Attorney

Please note that a new power of attorney for this case was filed on August 23, 2001. As noted on this power of attorney, please address all future correspondence to M. Todd Mitchem, Merchant & Gould, P.O. Box 2903, Minneapolis, MN 55402-0903, telephone 404.954.5033.

Conclusion

The foregoing is submitted as a full and complete response to the final official action mailed May 9, 2001. For at least the reasons set forth above, applicant submits that the claims pertaining to patentable subject matter. Applicant therefore respectfully requests allowance of the claims. Should the Examiner believe that anything further is necessary to place the application in better condition for allowance, the Examiner is respectfully requested to contact applicant's undersigned attorney at 404.954.5033.

Respectfully submitted,



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